

Remarks/Arguments

The preceding amendments and following remarks are submitted in response to the non-final Office Action mailed December 28, 2005, setting a three month shortened statutory response ending March 28, 2006. With this Amendment, claims 29-30, 38, and 42 have been amended, claims 43-49 have been cancelled, and claims 50-52 have been added. Claims 29-42 and 50-52 remain pending in this application. Reconsideration, examination and allowance of all pending claims are respectfully requested.

Claim Objections

In paragraphs 1-6 of the Office Action, the Examiner objected to various informalities regarding claims 30, 38, 43, 45-47, and 49.

In response to these objections, Applicants have amended claims 30 and 38 to address the informalities cited by the Examiner. In particular, claim 30 has been amended changing the word "hemocompatibliity" to "hemocompatibility". Claim 38 has been amended to insert a period "." after the word "core". Claims 43-49 have been cancelled, obviating the Examiner's objections of these claims.

Specification Objections

In paragraph 7 of the Office Action, the Examiner objected to the Abstract, stating that the abstract exceeds 150 words.

In response to this objection, Applicants have amended the Abstract to comply with the word requirement under MPEP § 608.01(b). Applicants assert that this amendment overcomes the Examiner's objections to the Specification.

35 U.S.C. § 112 Rejections

In paragraph 9 of the Office Action, the Examiner rejected claims 42-49 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

With this Amendment, Applicants have amended independent claim 42 to recite that the coil wire comprises a continuous wire including a plurality of alternating regions of radiopacity,

which Applicants submit is sufficiently enabled within the specification. Furthermore, Applicants have cancelled claims 43-49, rendering the Examiner's rejection of these claims moot.

35 U.S.C. § 102(b) Rejections

In paragraph 11 of the Office Action, the Examiner rejected claims 29-31, 34-35, 39-40, and 42-49 under 35 U.S.C. § 102(b) as being anticipated by *Erickson et al.* (U.S. Patent No. 5,664,580).

With this Amendment, Applicants have amended independent claim 29 to now recite that the elongate wire forming the coil comprises a continuous wire. Claim 29 now recites in full:

29. A guide wire comprising:

an elongate wire including a core having an outer surface having an area per unit length, a tubular first layer disposed about the core having an inner surface having an area per unit length of no more than the area per unit length of the outer surface of the core, wherein a portion of the layer has a topology selected from the topology of a single-lumen tube or the topology of a single-lumen tube having a slit;

wherein the elongate wire has a first property over a first portion and a second property over a second portion, wherein the first property is different from the second property, and wherein the elongate wire is formed into a coil; and

wherein the elongate wire forming the coil comprises a continuous wire.

Unlike claim 29 above, the *Erickson et al.* reference cited by the Examiner does not disclose or suggest that the elongated wire forming the coil comprises a continuous wire. Instead, the *Erickson et al.* reference appears to disclose a guidewire including a number of separate coil segments that are bonded to each other in an end-to-end configuration forming a non-continuous coil that extends over a portion of the guidewire. In one such embodiment depicted in Figure 1, for example, a coil (20) is formed by bonding a proximal coil segment (22) to a distal segment (24), each segment (22,24) having a different radiopaque property. In other embodiments described in *Erickson et al.*, additional coil segments can be bonded together in an end-to-end configuration to further vary the radiopaque properties of the guidewire.

Thus, because the *Erickson et al.* reference does not disclose that the elongated wire forming the coil comprises a continuous wire, Applicants respectfully assert that claim 29 is not

anticipated by the cited prior art. In addition, because independent claim 29 is allowable, Applicants submit that dependent claims 30-31, 34-35, and 39-40 are also allowable for at least the reasons provided above, and since they contain other limitations not disclosed or suggested by the cited prior art.

With respect to the rejection of claim 42, Applicants have amended that claim to now recite that the coil wire comprises a continuous wire including a plurality of alternating regions of radiopacity. As discussed above, the *Erickson et al.* reference cited by the Examiner does not disclose or suggest that the coil wire comprises a continuous segment of wire. Instead, *Erickson et al.* appear to suggest a non-continuous coil formed by bonding multiple coil segments together. Therefore, Applicants assert that claim 42 is also in condition for allowance.

35 U.S.C. § 103(a) Rejections

In paragraph 13 of the Office Action, the Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over *Erickson et al.* (U.S. Patent No. 5,664,580) as applied to claim 29 above, and further in view of *Jalisi* (U.S. Patent No. 6,679,853). In paragraph 14 of the Office Action, the Examiner further rejected claim 41 under 35 U.S.C. § 103(a) as being unpatentable over *Erickson et al.* (U.S. Patent No. 5,664,580) as applied to claim 29 above, and further in view of *Rooney et al.* (U.S. Patent No. 6,306,105).

For at least the reasons provided above, Applicants respectfully assert that the cited prior art references do not render dependent claims 32 and 41 obvious. As discussed above, the *Erickson et al.* reference does not disclose or suggest that the elongate wire forming the coil comprises a continuous wire, as recited in independent claim 29. Instead, *Erickson et al.* appears to suggest a non-continuous coil wire formed from multiple coil segments bonded together. The *Jalisi* and *Rooney et al.* references cited by the Examiner further fail to disclose or suggest this feature. Thus, because the cited prior art fails to disclose each and every claim limitation of claim 29, Applicants respectfully submit that dependent claims 32 and 41 are not obvious.

Allowable Subject Matter

In paragraph 15 of the Office Action, the Examiner objected to claims 33 and 36-38 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

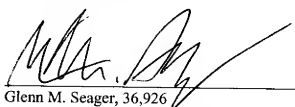
As discussed above, independent claim 29 has been amended to recite that the elongate wire forming the coil comprises a continuous wire, which is not taught by the cited prior art. Therefore Applicants believe that dependent claims 33 and 36-38, which depend from claim 29, are also allowable over the cited prior art.

With this Amendment, Applicants have added newly presented claims 50-52, which Applicants submit are also in condition for allowance. Claim 50 is similar to claim 29, but has incorporated the limitation contained in dependent claim 33, which the Examiner indicated would be allowable. Claim 51 is also similar to claim 29, but has incorporated the limitation contained in dependent claim 36, also indicated to be allowable by the Examiner. Claim 52 is also similar to claim 29, but has incorporated the limitation contained in dependent claim 37, also indicated to be allowable by the Examiner.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance, and issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 359-9348.

Respectfully submitted,

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